

REMARKS

Claim Amendments

Claims 20-21, 41-42 and 46-47 are pending herein. Claim 20 has been amended to specify that C* is selected from 5-hydroxycytosine, 5-hydroxymethylcytosine, N4-alkylcytosine and 4-thiouracil. No new matter has been added.

Written Description

Claims 20, 21 and 41 are currently rejected under 35 U.S.C. § 112, first paragraph as failing to meet the written description requirement. The essence of this rejection is that C* encompasses any modified pyrimidine and that different functional effects would be expected for different structures within this broad class of compounds. This rejection has been overcome by amendment.

Claim 20 has been amended to specify that C* is selected from 5-hydroxycytosine, 5-hydroxymethylcytosine, N4-alkylcytosine and 4-thiouracil. Thus, claim 20 no longer encompasses any modified pyrimidine, but only such modified pyrimidines that are specifically taught in the specification. Thus, Applicants respectfully submit that amended claim 20 satisfies the written description requirement and request that this rejection be withdrawn.

Double Patenting

Claims 20-21, 41-42 and 46-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over various claims of U.S. Patents Nos. 7262286, 7405285, 7427405, 7470674, 7498425, 7566702, 7595305, 7517862, and 7407944.

Without admitting the obviousness of claims 20-21, 41-42 and 46-47 over any of these claims, and solely for the sake of expediting prosecution, Applicants submit herewith a terminal disclaimer over US Patents Nos. 7262286, 7405285, 7427405, 7470674, 7498425, 7566702, 7595305, 7517862, and 7407944. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 20-21, 41-42 and 46-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over various claims of co-pending US Application Publications Nos. 20040198685, 20050026858, 20050026861,

20050130918, 20050222072, 20060014713, 20060074040, 20060217328, 20060287262, 20070219153, 20080152662, 20080193437, and 20080279785. Of these, Publication No. 20050026858 has the same priority date as the instant application, and all of the other Publications have later priority dates than the instant application.

MPEP § 804(B)(1) provides, in relevant part, that “If a ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.”

Applicants respectfully submit that the amendment of claim 20 has overcome the rejection of that claim for failure to meet the written description requirement, that the ODP rejections over Applicants’ own patents has been overcome by timely submission of a terminal disclaimer, and thus, that these provisional ODP rejections are the only rejections remaining in the instant, earlier-filed application. Thus, Applicants respectfully request that the instant application be passed to issue without a terminal disclaimer over the pending applications.

CONCLUSION

In view of the above amendments and remarks, it is believed that claims 20-21 41-42 and 46-47 are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner believes that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned attorney at 207-791-3078.

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Respectfully submitted,

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Preti Flaherty
One City Center
Portland, ME 04112
Telephone: 207/791-3000
Facsimile: 207/791-3111

By: /Wayne A. Keown/
Wayne A. Keown, Ph.D.
Registration No. 33,923